IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION

PERSONALWEB TECHNOLOGIES, LLC AND LEVEL 3 COMMUNICATIONS, LLC Plaintiff, vs. NEC CORPORATION OF AMERICA, INC. Defendant.	§	**CASE NO. 6:11-CV-655 (LED)** **PATENT CASE** **JURY TRIAL DEMANDED**
PERSONALWEB TECHNOLOGIES, LLC AND LEVEL 3 COMMUNICATIONS, LLC Plaintiff, vs. NETAPP, INC. Defendant.	§	**CASE NO. 6:11-CV-657 (LED)** **PATENT CASE** **JURY TRIAL DEMANDED**
PERSONALWEB TECHNOLOGIES, LLC AND LEVEL 3 COMMUNICATIONS, LLC Plaintiff, vs. AMAZON.COM, INC.; AMAZON WEB SERVICES LLC; and DROPBOX, INC. Defendants.	§	**CASE NO. 6:11-CV-658 (LED)** **PATENT CASE** **JURY TRIAL DEMANDED**

PERSONALWEB TECHNOLOGIES, LLC AND LEVEL 3 COMMUNICATIONS, LLC Plaintiff, vs. CARINGO, INC. Defendant.	§	**CASE NO. 6:11-CV-659 (LED)** **PATENT CASE** **JURY TRIAL DEMANDED**
PERSONALWEB TECHNOLOGIES, LLC AND LEVEL 3 COMMUNICATIONS, LLC Plaintiff, vs. EMC CORPORATION, and WMWARE, INC. Defendants	§	**CASE NO. 6:11-CV-660 (LED)** **PATENT CASE** **JURY TRIAL DEMANDED**
PERSONALWEB TECHNOLOGIES, LLC AND LEVEL 3 COMMUNICATIONS, LLC Plaintiff, vs. AUTONOMY, INC., HEWLETT-PACKARD COMPANY, AND HP ENTERPRISE SERVICES, LLC, Defendant.	§	**CASE NO. 6:11-CV-683 (LED)** **PATENT CASE** **JURY TRIAL DEMANDED**
PERSONALWEB TECHNOLOGIES, LLC. AND LEVEL 3 COMMUNICATIONS, LLC Plaintiff, vs. GOOGLE INC. AND YOUTUBE, LLC. Defendants.	§	**Civil Action No. 11-cv-656 (LED)** **PATENT CASE** **JURY TRIAL DEMANDED**

NOTICE OF FILING JOINT BRIEF FOR ENTRY OF AN E-DISCOVERY ORDER

On July 23, 2012, the parties filed a joint motion for entry of a discovery order. While the parties reached agreement on the content of the discovery order, they did not agree on the form of an e-discovery stipulation to accompany that order. The parties agreed to present their joint briefing on the e-discovery order to the Court and ask that the Court, after review of the briefing, enter an e-discovery order in this case.

Plaintiff PersonalWeb's Arguments in Support of its Proposed E-Discovery Order

PersonalWeb Technologies LLC moves for entry of the Eastern District of Texas' Model Order Regarding E-Discovery in Patent Cases (Appendix P to the Local Rules of the Eastern District of Texas). Dkt 79-2. The Court's model order adequately balances the interests of the parties in conducting timely and relevant electronic discovery. While PersonalWeb believes the Court's model order strikes the proper balance of interests for electronic discovery in these cases, Defendants propose an alternative, which deviates from the Court's model order in significant respects.

Defendants' proposed electronic discovery order would not permit any e-mail production requests until June 16, 2013 – nearly a year from today and shortly before the *Markman* hearing in this case. There is no basis for delaying e-mail production until this time, particularly when such production might reveal additional custodians with relevant information regarding case issues. The Court's model order contemplates that electronic discovery requests can be completed following the service of initial disclosures, information regarding custodians and invalidity contentions. Court's Model Order at ¶ 9. Defendants' attempt to delay e-mail production is unwarranted and will needlessly hold up discovery in this case.

Defendants' proposed electronic discovery order cuts significantly the number of custodians from which a party can seek e-mail production to just 3 custodians. Given the scope of the Accused Products and individuals involved in their development, this is unduly restrictive. Moreover, defendants have inserted the onerous provision that if a party requests additional custodians from the Court and the Court grants the request, "the requesting party shall bear all fees and costs associated with that collection and production." Defs. Proposal at ¶ 8. A party may discover the identity of relevant custodians, not previously disclosed or revealed, as the case proceeds. If the Court has determined that a party has demonstrated a sufficient basis for seeking additional e-mail custodians, that party should not bear the costs. Defendants' proposal is particularly unrealistic when taken in tandem with its plan to limit custodians to just 3. In contrast, the Court's model order is better suited for this case because it will enable the parties to conduct adequate e-mail discovery of identified custodians and individuals with knowledge. The Court's model order permits up to 8 custodians per producing party. Court's Model Order at ¶ 8. Moreover, the Court's order does not shift the cost to the requesting party if it successfully demonstrates that additional custodians are required based "on the size, complexity and issues of this specific case." Court's Model Order at ¶ 8.

Defendants also seek to slice by half from the Court's model order the number of search terms that can be sought from each custodian. The defendants propose just 5 search terms, while the Court's Model Order allows 10 search terms. Court's Model Order at ¶ 9. The 5 search term limit proposed by defendants would not allow for meaningful searches on issues, including but not limited to development of the accused products and knowledge of the patents-in-suit.

Defendants have included a provision limiting email production requests to "specific issues, rather than general discovery of a product or business." This provision is ambiguous, but

in any event, is an unnecessary constraint on a parties' ability to seek e-mail discovery. The parties necessarily will engage in a meet and confer process that will allow them to determine the appropriate custodians and processes. The Court's Model Order contains no such provision.

Defendants also include language requiring that a party demonstrate "good cause" before it can receive documents in native format (including for example oversized documents or spreadsheets). Parties should not have to make such a showing if they are making a reasonable request for native documents. The Court's Model Order places no similar burden.

The variations proposed by defendants are unnecessary and undo the Court's proposed model to afford the parties' sufficient but measured electronic discovery. PersonalWeb requests that the Court adopt its model order without any alterations to govern electronic discovery.

Defendants' Arguments in Support of their Proposed E-Discovery Order

The main difference between the parties' competing e-discovery proposals relates to the production of email. Defendants' proposal adheres to this Court's admonition to the parties to maximize efficiencies and will streamline what is typically the most expensive component of patent litigation: discovery. "Patent cases, in particular, tend to suffer from disproportionally high discovery expenses." Ex. A, Federal Circuit Advisory Council, *An E-Discovery Model Order* 1 (2011).[1] Plaintiff's proposal, meanwhile, imposes significant burdens of searching, reviewing, and producing email—burdens that are much greater on defendants than plaintiff—with little to no benefit. PersonalWeb's proposal is another example of its attempts to conflate "streamlining" with proposals that strategically inure solely to the benefit of PersonalWeb.

[1] Available at http://www.cafc.uscourts.gov/2011/model-e-discovery-order-adopted-by-the-federal-circuit-advisory-counsel.html.

PersonalWeb's proposal that this Court adopt the email limitations set forth in the standard Eastern District of Texas Model Order—which can be sensibly applied in many cases—ignores the minimal relevance that email will have to these specific cases. The Federal Circuit Model Order puts email production in context:

> Most discovery in patent litigation centers on what the patent states, how the accused products work, what the prior art discloses, and the proper calculation of damages. These topics are normally the most consequential in patent cases. Thus, far reaching e-discovery, such as mass email searches, is often tangential to adjudicating these issues.

Id. at 2. PersonalWeb proposes that the parties exchange lists of fifteen email custodians, meet to discuss the lists, and then search and produce emails across twice as many custodians (8 vs. 3) and search terms per custodian (10 vs. 5) as defendants. *Compare* D.E. 42 Ex. 2, Pl. Proposed E-Discovery Order at ¶¶ 7-9, *with* D.E. 42 Ex. 3, Def. Proposed E-Discovery Order at ¶¶ 7-9.

But defendants' relevant information will take the form of technical documents and product/sales information—not emails. Thus, the burdens associated with identifying fifteen potential email custodians for each party, narrowing the list, and searching, reviewing, and producing emails far outweigh what little probative value emails might have in these cases. Defendants' proposal (3 custodians, 5 search terms each) gives appropriate weight to the limited relevance of email, and it includes a provision tracking the language of the Federal Circuit Model Order that limits email discovery requests to specific issues rather than for general discovery purposes. Defendants' proposal therefore strikes the appropriate balance between allowing for limited, targeted email production and minimizing the parties' burdens regarding email in a case in which email discovery will be of little, if any, relevance. If developments in the cases indicate that additional custodians or search terms are necessary, Defendants' proposal allows for an

agreement between the parties or an order by the Court to increase the custodian or search term limits.

PersonalWeb's proposal pays lip service to "streamlining" and stands in stark contrast to the significant limitations it seeks to impose on defendants with respect to other aspects of these litigations—namely, limitations on prior art references. PersonalWeb's brief in support of its proposed Docket Control Order bemoans the difficulties associated with determining what claims to assert as a justification for a premature limitation on the number of prior art references upon which defendants may rely. *See* D.E. 33. Limiting the scope of email searching and production will have a far greater effect on streamlining these litigations than limiting prior art, without any effect on the parties' ability to advance their theories and defenses. Accordingly, defendants' proposal to limit email discovery based largely upon the Federal Circuit Model Order would achieve streamlining and efficiency, and should be adopted in these cases.[2]

DATED: July 25, 2012

Respectfully submitted,
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[2] Defendant NEC of America, Inc. ("NECAM") notes that the parties' e-discovery proposals also differ as to whether documents must be produced in text-searchable format. NECAM agrees with plaintiff's proposal on this point (plaintiff's Proposal ¶ 5(B)) that documents need ***not*** be produced in text-searchable format.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3)(A) on July 25, 2012.

/s/ Samuel F. Baxter
Samuel F. Baxter

CERTIFICATE OF CONFERENCE

I hereby certify that, on the 25th day of July, 2012, counsel for the above-named parties met and conferred via email pursuant to Local Rule CV-7(h) regarding electronic discovery. The parties did not come to an agreement regarding the proposed stipulation.

/s/ Samuel F. Baxter
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